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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/708,696

03/18/2004

Peter Lin

2695

42428

7590

01/22/2008

PETER LIN

88 BJORKLUND AVE

WORCESTER, MA 01605-1071

EXAMINER

FERNANDEZ RIVAS, OMAR F

ART UNIT

PAPER NUMBER

2129

MAIL DATE

DELIVERY MODE

01/22/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/708,696	<b>Applicant(s)</b> LIN ET AL.	
	<b>Examiner</b> Omar F. Fernández Rivas	<b>Art Unit</b> 2129	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1-46 are pending on this application.

#### ***Information Disclosure Statement***

2. The information disclosure statement has not been filed for this application. To comply with 37 CFR 1.98(a)(1), the following is required: (1) a list of all patents, publications, applications, or other information submitted for consideration by the Office; (2) U.S. patents and U.S. patent application publications listed in a section separately from citations of other documents; (3) the application number of the application in which the information disclosure statement is being submitted on each page of the list; (4) a column that provides a blank space next to each document to be considered, for the examiner's initials; and (5) a heading that clearly indicates that the list is an information disclosure statement.

#### ***Specification***

3. The amendment filed on December 12, 2007 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: paragraphs 1 and 2 have been amended to include subject matter not contemplated in the original specification filed.

Applicant is required to cancel the new matter in the reply to this Office Action.

4. It is also noted that the amended specification filed does not contain the markings of the subject matter deleted from the original specification filed.

***Claim Objections***

5. The reply filed on December 12 is not fully responsive to 37 CFR §1.121 because of the following omission(s): All claims being currently amended must be presented with markings to indicate the changes that have been made relative to the immediate prior version. The changes in any amended claim must be shown by strike-through (for deleted matter) or underlining (for added matter) with 2 exceptions: (1) for deletion of five or fewer consecutive characters, doublebrackets may be used (e.g., [[error]]); (2) if strike-through cannot be easily perceived (e.g., deletion of number "4" or certain punctuation marks), double brackets must be used (e.g., [[4]]). As an alternative to using double brackets, however, extra portions of text may be included before and after text being deleted, all in strike-through, followed by including and underlining the extra text with the desired change. Also note that the status of each claim must be annotated (original, amended, new...).

6. Claims 2-46 are objected to because of the following informalities: the claims should include a transition word after the phrase "a system according to claim 1". For Example, claim 2 could recite: "A system according to claim 1 wherein the system converts an object...".

7. Claims 2-46 recite: "a system according to claim 1...". However, no such system is recited in claim 1.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 1-46 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not contain a concise and clear description of the steps or processes performed by the invention. A person of ordinary skill in the arts would not be able to replicate the invention without undue experimentation since the specification does not provide a sufficient description of the invention claimed. Moreover, this lack of description would prevent a person of ordinary skill in the arts to even understand the metes and bounds of the invention.

Claim 1 recites the "RETE algorithm", "novel extensions" and a set of "rules". The specification does not provide an explanation of what the RETE algorithm is, what it does or how it is used. There is also no description in as to what these "extensions" are or how the RETE algorithm is modified to include these extensions. There is also no description as to what these rules are or how they are implemented in the claimed

invention. The subject matter claimed in claims 2-46 also lack a proper description in the specification and are therefore rejected.

***Claim Rejections - 35 USC § 101***

10. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim1 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claim does not fall within at least one of the statutory categories of patent eligible subject matter (process, machine, manufacture or composition of matter). Moreover, the claim appears to be a system of software per se and therefore non-statutory. As set forth in paragraph 2 of the amended specification, the invention is a computer program, which does not fall within one of the statutory categories of patent eligible subject matter. A claim that recites a piece of software alone without any link to a hardware component (computer readable medium) is directed to non-statutory subject matter since there is no relationship between the computer software and hardware components which permits the functionality of the software to be realized.

11. Claims 1-46 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The computer system must set forth a practical application of judicial exception to produce a real-world result. Benson, 409 U.S. at 71-

72, 175 USPQ at 676-77. The invention is ineligible because it has not been limited to a substantial practical application.

For a claimed invention to be statutory the claimed invention must produce a useful, concrete, and tangible result. As the Supreme Court has made clear, "[a]n idea of itself is not patentable," *Rubber-Tip Pencil Co. v. Howard*, 20 U.S. (1 Wall.) 498, 507 (1874); taking several abstract ideas and manipulating them together adds nothing to the basic equation. In re Warmerdam, 31 USPQ2d 1754 (Fed. Cir. 1994).

For a claimed invention to be statutory under 35 U.S.C. 101, the claims must produce a practical application by 1) transforming (physical thing) or 2) having the FINAL RESULT (not the steps) produce a useful (specific, substantial, AND credible), concrete (substantially repeatable/ non-unpredictable), AND tangible (real world/ non-abstract) result.

A claim that recites a computer that solely calculates a mathematical formula is not statutory.

In the present case, claim 1 describes a rule engine which implements the RETE algorithm with novel extensions. However, the claim does not provide for a useful result because the claimed subject matter fails to sufficiently reflect at least one practical utility for the invention claimed. Moreover, the claim does not even recite a result obtained from implementing the invention.

The claim also fails to produce a concrete result because the claimed subject matter fails to be limited to the production of an assured, repeatable result. More specifically, the claimed subject matter is not repeatable because there is no restriction

in the claim as to how the rules are selected by the rules engine and applied to the patterns, how these patterns are distributed or even how the extensions are applied to the RETE algorithm. Therefore, the system may not always produce the same results given the same inputs.

Claim 1 also fails to produce a tangible result because the claimed subject matter fails to produce a result that is limited to having real world value rather than a result that may be interpreted to be abstract in nature as, for example, a thought, a computation, or manipulated data.

Claims 2-46 further limit claim 1 but fail to cure the deficiencies set forth above in reference to claim 1 and are therefore rejected on the same basis.

### **Response to Applicant's arguments**

12. It is noted that the Applicant's arguments (remarks) were not filed in a separate sheet of paper.

13. The Applicant's arguments have been fully considered but are not persuasive. The Amendments made on the claims do not overcome the rejections set forth above.

### **Conclusion**

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not



mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

15. Claims 1-46 are rejected.

***Correspondence Information***

16. Any inquires concerning this communication or earlier communications from the examiner should be directed to Omar F. Fernández Rivas, who may be reached Monday through Friday, between 8:00 a.m. and 5:00 p.m. EST. or via telephone at (571) 272-2589 or email [omar.fernandezrivas@uspto.gov](mailto:omar.fernandezrivas@uspto.gov).

If you need to send an Official facsimile transmission, please send it to (571) 273-8300.

If attempts to reach the examiner are unsuccessful the Examiner's Supervisor, David Vincent, may be reached at (571) 272-3080.

Hand-delivered responses should be delivered to the Receptionist @ (Customer Service Window Randolph Building 401 Dulany Street Alexandria, VA 22313), located on the first floor of the south side of the Randolph Building.



Omar F. Fernández Rivas  
Patent Examiner  
Artificial Intelligence Art Unit 2129  
United States Department of Commerce  
Patent & Trademark Office



DAVID VINCENT 11/17/28  
SUPERVISORY PATENT EXAMINER